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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/780,997	02/09/2001	Ken Kutaragi	SCEI 18.303	5883

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EXAMINER

SON, LINH L D

ART UNIT PAPER NUMBER

2135

DATE MAILED: 05/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/780,997

Applicant(s)

KUTARAGI ET AL.

Examiner

Linh LD Son

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-12 and 14-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9-12 and 14-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is responding to the Amendment received on 02/15/06.
2. Claims 1-7, 9-12, and 14-22 are pending.
3. Claim 22 is a newly added claim.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-7, 9-12, and 14-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rhoads et al, US Patent No. 6522769B1, hereinafter "Rhoads", in view of Melnychuck et al, EP/0651554A1, hereinafter "Melnychuck".
6. As per claims 1-3, and 22:

Rhoads discloses "a method of providing a content, characterized in that: when a content is transmitted to a user, an electronic water mark for preventing execution of said content is embedded in said content and at least information associated with the user, to whom said content is to be transmitted, is added to said content" in (Col 10 line

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59 to Col 11 line 50, and Col 15 lines 15-50); and "when said content is executed, said information associated with the user who has received said content is checked at both transmitting and receiving ends, and the execution of said content is allowed by removal of said electronic water mark if and only if the result of the checking indicates that said content is an authorized content" in (Col 11 lines 29-47).

However, Rhoads does not specifically teach when said content is executed, said information associated with the user who has received said content is checked at transmitting end, and the execution of said content is allowed by removal of said electronic water mark if and only if the result of the checking indicates that said content is an authorized content.

Nevertheless, Melnychuck discloses the "Method and apparatus for the addition and removal of digital watermarks in a hierarchical image storage and retrieval system" invention, which including step of watermark removal after an authorization of the transmitting end is received in (Col 4 lines 30-48, Col 5 lines 35-42, and Col 9 lines 20-40).

Therefore, it would have been obvious at the time of the invention was made for one having ordinary skill in the art to modify Rhoads' invention to incorporate the Melnychuck's removing the watermark method using the authorization code sent from the server after checking indicates that said content is an authorized content with the motivation of completely authorizing the usage of the content for a payment in exchange.

7. As per claims 4-5, 9-10, and 14-15:

Rhoads teaches "a content providing system comprising: a content provider including a content server which stores plural kinds of digital contents and also including in which information associated with a user is registered" in (Col 11 lines 35-45); "at least one user terminal; and a network for connecting said at least one user terminal to said content provider" in (Col 10 lines 50-65), "wherein: said content provider includes a user database for registering, in advance, information associated with a user received from said at least one user terminal; when said content provider receives from a user terminal a request for providing a particular content, said content provider requests said user terminal to resend the information associated with said user and transmits the requested content combined with said information associated with said user after checking that said information associated with said user is consistent with the information registered in said user database" in (Col 10 line 45 to Col 11 line 50); "when the content transmitted from said content provider is executed at said user terminal, said user terminal checks whether the information associated with said user included in the content is consistent with the information stored in the user terminal; and in accordance with the result of the checking performed at said user terminal, said content provider determines whether to transmit a content execution permission command to said user terminal wherein: said content provider further includes encryption means for encrypting the information associated with a user and embedding an electronic watermark in said content for preventing execution of said content. and. when said content provider receives from a user terminal a request for providing a particular content, said content-provider transmits the requested content after combining the

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requested content with the information associated with said user and with the electronic watermark: and wherein said content execution permission command transmitted from said content provider serves to remove said electronic watermark for allowing execution of said content" in (Col 10 line 45 to Col 11 line 50).

However, Rhoads does not specifically teach when said content is executed, said information associated with the user who has received said content is checked at transmitting end, and the execution of said content is allowed by removal of said electronic water mark if and only if the result of the checking indicates that said content is an authorized content.

Nevertheless, Melnychuck discloses the "Method and apparatus for the addition and removal of digital watermarks in a hierarchical image storage and retrieval system" invention, which including step of watermark removal after an authorization of the transmitting end is received in (Col 4 lines 30-48, Col 5 lines 35-42, and Col 9 lines 20-40).

Therefore, it would have been obvious at the time of the invention was made for one having ordinary skill in the art to modify Rhoads' invention to incorporate the Melnychuck's removing the watermark method using the authorization code sent from the server after checking indicates that said content is an authorized content with the motivation of completely authorizing the usage of the content for a payment in exchange.

8. Claims 6 and 11:

Rhoads teaches "A content providing system according to one of Claims 4-5 and 9-10, wherein said information associated with the user includes at least a user name, a password, and a device ID uniquely assigned to a device of said user" in (Col 11 lines 29-46).

9. Claims 7 and 12:

Rhoads teaches "a content providing system according to one of claims 4-5 and 9-10, wherein said information associated with a user received from a user terminal is registered, in advance, in the user database of said content provider, said content provider transmits to said user a card on which a card ID is stored said information associated with the user includes at least a user name, a password, a device ID uniquely assigned to a device of said user, and said card ID" in (Col 11 lines 29-46, and Col 26 lines 40-48).

10. As per Claim 16:

Melnychuck teaches "The method of claim 1, wherein when the result of the checking indicates that said content is an authorized content, key information for removal of said electronic watermark is transmitted to the user" in (Col 4 lines 35-45).

11. As per Claim 17:

Melnychuck teaches "The method of claim 16, wherein the key information represents a data location of said content at which the electronic watermark is embedded" in (Col 4 lines 35-45).

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12. As per Claims 18 and 21:

Melnychuck teaches "The method of claim 16". However, Rhoads and Melnychuck does not specifically teach "further comprising the step of deleting the key information by the user after removal of the electronic watermark". Nevertheless, it would have been obvious at the time of the invention was made for one having ordinary skill in the art to modify the invention to implement the deletion step to provide a security mechanism to protect the apprehension of the key.

13. As per Claim 19:

Melnychuck teaches "The content providing system of claim 4, wherein said content execution permission command transmitted from said content provider includes key information representing a data location of the content at which the electronic watermark is embedded" in (Col 4 lines 35-45).

14. As per Claim 20:

Melnychuck teaches "The content providing method of claim 14, wherein the key information represents a data location of the content at which the electronic watermark is embedded" in (Col 4 lines 35-45).

Response to Arguments

15. Applicant's arguments filed on 02/15/06 have been fully considered but they are not persuasive.

16. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "...it is checked whether a device ID 33 in the header of the content is identical to an actual device ID of a user terminal..." in Page 13) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

17. As per remark on page 13 2nd paragraph, Applicant argues that "neither of the references discloses or suggests that "when said content is executed, said information associated with the user who has received said content is checked at both transmitting and receiving ends, and the execution of said content is allowed by removal of said electronic water mark if and only if the result of the checking indicates that said content is an authorized content". Examiner traverses Applicant's argument. Rhoads discloses a method of distributing watermarked content to multiple users. When the user invokes the watermarked content, the device decodes the watermark and verifies if the content is executable based on the information in the watermark and the device (see Col 13 lines 10-50). However, Rhoads does not specifically teach of checking at the transmitting end whether to allow the execution of the content and removing the

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watermark if allowed. Nevertheless, Melnychuck discloses a method of acquiring authorization code or key with the transmitting end by a form of payment to remove the watermark from the content for execution. It is clearly obvious at the time of the invention was made for one having ordinary skill in the art to incorporate Rhoads' and Melnychuck's teaching to allow the user to have full access after removing the content by making a payment or get authorization at the transmitting end.

18. As per remark on page 15 in regarding to claim 16, Melnychuck clearly discloses "the result of the checking indicates that said content is an authorized content, key information for removal of said electronic watermark is transmitted to the user" in (Col 4 lines 35-45, and Col 9 lines 20-30). It is clearly cited that the professional provides to the customer the authorized information, such as key, to remove the watermark.

Applicant's argument is traversed.

19. Similar rejection is applied for all independent claims. See rejection above.

20. For the sake of clarification, Examiner decided to make this office action to a Non-Final Office Action.

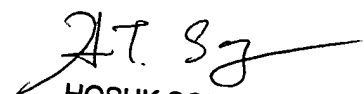
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21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Linh LD Son whose telephone number is 571-272-3856. The examiner can normally be reached on 9-6 (M-F).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Linh LD Son
Examiner
Art Unit 2135


HOSUK SONG
PRIMARY EXAMINER